

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of

Karl Friedrich Laible

Serial No. 10/725,088

Filed: December 1, 2003

Atty. Ref.: 2001P14020WOUS

TC/A.U.: 3637

Examiner: Hanh Van Tran

For: COLD GOODS CONTAINER FOR A COOLING APPARATUS

* * * * *

September 2, 2009

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences (the Board) from the decision of the Examiner in an Office Action dated April 28, 2009, finally rejecting all of the claims remaining in the application. A Notice of Appeal was filed on July 28, 2009. The Appeal Brief submitted herewith is therefore proper and timely.

TABLE OF CONTENTS

(I)	REAL PARTY IN INTEREST	3
(II)	RELATED APPEALS AND INTERFERENCES.....	4
(III)	STATUS OF CLAIMS	5
(IV)	STATUS OF AMENDMENTS	6
(V)	SUMMARY OF CLAIMED SUBJECT MATTER	7
(VI)	GROUND OF REJECTION TO BE REVIEWED ON APPEAL.....	10
(VII)	ARGUMENT	11
(VIII)	CLAIMS APPENDIX.....	19
(IX)	1. EVIDENCE APPENDIX.....	22
(X)	RELATED PROCEEDINGS APPENDIX	23

Karl Friedrich Laible
Serial No. 10/725,088

(I) REAL PARTY IN INTEREST

The real party in interest is the assignee, BSH BOSCH UND SIEMENS
HAUSGERÄTE GmbH, by virtue of an assignment recorded in the USPTO on August 8,
2005 at Reel 016364, Frame 0150.

(II) RELATED APPEALS AND INTERFERENCES

The appellants and the undersigned are not aware of any related appeals, interferences, or judicial proceedings (past or present), which will directly affect or be directly affected by, or have a bearing on the Board's decision in this appeal.

(III) STATUS OF CLAIMS

Claims 1, 2, 4-14 and 19-21 are pending in the application. Claims 3 and 15-18 have been cancelled. Non-elected claims 7-9 remain withdrawn from consideration. A correct and accurate copy of the appealed claims 1, 2, 4-6, 10-14 and 19-21 is provided in Section VIII, "Claims Appendix."

(IV) STATUS OF AMENDMENTS

Applicant filed “Amendment C” on June 15, 2009 in response to the Office Action of April 28, 2009 finally rejecting the claims on appeal. In that Amendment, applicant proposed cancellation of dependent claims 3 and 15. In an Advisory Action dated July 6, 2009 the Examiner denied entry of the proposed “Amendment C”. A Request for Reconsideration was filed on August 11, 2009. In a second Advisory Action dated August 17, 2009, the Examiner granted the Request, indicating that “Amendment C” would be entered. Thus, dependent claims 3 and 15 have been cancelled.

(V) **SUMMARY OF CLAIMED SUBJECT MATTER**

The invention relates to a guide assembly for a cold goods container, and to a cooling apparatus incorporating the guide assembly.

Initially, and by way of brief background, cold goods containers, particularly for household cooling appliances such as refrigerators and freezers, are frequently produced in one piece from plastic material by a molding process. To facilitate manufacture, the opposing walls of the container must be angled, i.e., the walls are not exactly parallel but rather, are formed to include a slight angle of divergence in the direction of the open front side of the cold goods container. The non-parallel disposition of the sidewalls leads to problems, however, when pullout shelves are to be installed in the container. Specifically, guide rails mounted on the container sidewalls would have to allow movement of a pullout shelf that is guided on the rails not only in the longitudinal direction of the rails but also to a smaller degree, in a transverse direction as well. The amount of play required to accommodate this bi-directional movement conflicts with precise and smooth guidance of the rails.

To prevent such a problem from occurring in conventional cooling apparatus, the sidewalls of the cold goods container are formed with what is referred to as a 0°- deformation angle along the sidewall regions in which the pullout shelf is to be mounted. That is, sidewall portions in these regions extend exactly parallel to one another.

The production of exactly parallel sidewall portions, however, is associated with a substantial additional outlay in the molding process. Whereas a cold goods container with a molding bevel on all sides can be produced with the aid of simply constructed dies that move

back and forth only in a main direction, the production of sidewalls that are parallel to this main direction requires multipart dies with slides that are moveable in a direction other than the main direction.

This invention is intended to provide a cold goods container for a cooling apparatus that overcomes the above-mentioned disadvantages, but that can also still be produced with simple and inexpensive dies and that also allow exact guidance of a pullout shelf in the cold goods container.

With reference now to the specification, text and drawings, and in terms of independent claim 1 on appeal, the invention relates to a guide assembly comprising a compensating element 20 or 25 (page 10, line 25 through page 11, line 8; page 12, lines 5-11 and Figs. 3 and 6); at least one pair of guide rails 9, each of the guide rails being mountable on a respective sidewall 8 of a cold goods container 3 of a cooling apparatus, the pair of guide rails being operable to guide a pullout shelf 11 of a cold goods container such that the pullout shelf is configured to be guided by the pair of guide rails at least partway out of the cold goods container through an open front side of the cold goods container (page 9, line 23 through page 10, line 1 and Fig. 1); the compensating element (20 or 25) being configured to mount at least one guide rail 9 of each of the pair of guide rails at one of the sidewalls 8 at an acute angle to the sidewall 8, the angle being defined to extend the rails parallel to one another (page 10, lines 25 through page 11, line 8 and Fig. 3; page 12 lines 5-11 and Fig. 6; see also page 3, lines 5-16).

In dependent claim 2, additional limitations require that the compensating element comprise a plurality of compensating elements 20 or 25; each of the guide rails 9 having one

of the compensating elements 20 or 25; and wherein the compensating elements are mirror-symmetrical (page 3, lines 18-26).

In dependent claim 4, it is further required that the compensating element be formed at the guide rail in one piece. (page 4, lines 5-10; page 10, line 25 through page 11, line 8; page 12, lines 5-16 and Figs. 3 and 6)

In claim 5, it is further required that the compensating element be integral with the guide rail. (page 4, lines 1, 2; page 10 line 25 through page 11, line 8 and Figs. 3-5)

In dependent claim 6, it is further required that the compensating element be wedged-shape, and extend substantially over an entire length of the guide rail. (page 4, lines 1, 2; page 10 line 25 through page 11, line 8 and Figs. 3-5)

Dependent claims 10, 11 and 12 require that the guide rail 9 have a C-shaped cross-section with a top leg 12, 13, bottom leg 14, 15 and a centerpiece 16, 17 joining the top and bottom legs, with the further requirement that the compensating element 20 be formed in the centerpiece 17 (page 10, lines 15-26 and Figs. 3-6).

Dependent claim 13 requires the compensating element to have a contact surface and further requires that the guide rail carry, on the contact surface of the compensating element at least one hook. (page 4, line 25 through page 5, line 3; page 11 lines 10-16 and Fig. 3)

Dependent claim 14 requires that the guide rail have at least one hook. (page 4, line 25 through page 5, line 3; page 11 lines 10-16 and Fig. 3)

Independent claim 19 requires a cooling apparatus comprising at least one cold goods container 3 having an open front side; at least one pullout shelf 11; sidewalls diverging in a direction of the front side; and a guide assembly having a compensating element 20 or 25 (page 10, lines 25 through page 11, line 8 and Fig. 3; page 12 lines 5-11 and Fig. 6; see also

page 3, lines 5-16); at least one pair of guide rails 9 guiding the pullout shelf 11 at least partway out of the cold goods container 3 through the front side; the compensating element 20 or 25 mounting at least one guide rail of each of the pair of guide rails at one of the sidewalls at an acute angle to the sidewall, the angle being defined to extend the rails parallel to one another (page 10, lines 25 through page 11, line 8 and Fig. 3; page 12 lines 5-11 and Fig. 6; see also page 3, lines 5-16).

Dependent claim 20 depends from claim 1 requires a C-shaped cross-section with a top leg 12, 13, a bottom leg 14, 15 and a centerpiece 16, 17 joining the top and bottom legs, with the compensating element 20 be formed in the centerpiece. (page 10, lines 15-25 and Fig. 3-6)

Finally dependent claim 21 depends from claim 2 and further requires one hook protruding through an opening of a sidewall of a cold good container for a cooling apparatus (page 4, lines 25 through page 5, line 3; page 11, lines 10-15 and Fig. 3).

(VI) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. The rejection of claims 1-5, 10-15 and 19-21 as anticipated by DE 29817743 (DE '743) under 35 U.S.C. § 102(b).
2. The rejection of claim 6 as unpatentable over DE '743 in view of U.S. Pat. No. 6, 641,239 (Kaiser) under 35 U.S.C. 103.

(VII) ARGUMENT

1. DE ‘743 Does Not Anticipate Any of Claims 1, 2, 4, 5, 10-14 and 19-21.

In order to establish anticipation under 35 U.S.C. 102(b), the claimed invention must be the same as that of the reference, *Richardson v. Suzuki Motor Co.*, 868 F.2d. 1226, 9 USPQ 2d., 1913 (Fed. Cir. 1989). Thus, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in single prior art reference. *Verdegahl Bros. v. Union Oil Co. of California*, 814, Fed. 2d. 628, 631, 2USPQ 2d. 1051, 1053 (Fed. Cir. 1987). Moreover, the elements must be arranged as required by the claim, although this is not an *ipsissimis verbis*, i.e., identity of terminology is not required in re Bond 910, Fed. 2d. 831, 15 USPQ 2d. 1566 (Fed. Cir. 1990).

(a) Claims 1, 2, 4, 5, 13 and 19

(i) Claim 1

The Examiner contends that the DE ‘743 patent discloses a plurality of “compensating elements” 34-37 for mounting at least one guide rail of each of the pair of guide rails 32 to one of the side walls at an acute angle to the side wall, the angle being defined so as to extend the rails parallel to one another (claim 1). The Examiner further regards the compensating elements on the respective guide rails as mirror-symmetrical to each other (claim 2). See Final Rejection, p. 3.

The Examiner now also contends that the language in claim 1 (and claim 19) fails to provide adequate structural limitations defining/describing the compensation elements in order to distinguish over the prior art of record. See Advisory Action, p. 2. According to the

Examiner, if the prior art structure is capable of performing a recited intended use, then it meets the claim.

In fact, elements 34-37 comprise hooks punched from the centerpiece of the rails which enable attachment of the rails to the side walls of the cooling apparatus (See Fig. 4). These hooks or attachment elements are not configured to mount the respective guide rails 32 at an acute angle relative to the side wall, so as to make the guide rails parallel to each other. In this regard, there is nothing in the D '743 patent indicating that, e.g., both elements 36, 37 at one end of the guide rail 32, offset the guide rail from the side wall to a greater or lesser extent than elements 34, 35 at the other end of the rail (Figs. 2, 4). While the guide rails may in fact be installed at a slightly acute angle relative to the top wall of the cold goods container 11, there is nothing in the D '743 patent to suggest that there is any compensating element that is configured to mount the guide rails 32 at acute angles relative to the side walls of the container.

In the instant application, the compensating elements take two forms. In Figure 3, the compensating element is reflected in the design of the U-shaped channel 20 formed in the center piece 17 of the guide rail 9 (see Figs. 3-5), in that the lateral depth of the channel increases over the length of the guide rail to compensate for the divergence of the side walls 8 of the cold goods container 3, i.e., the compensating element is wedge-shaped.

In a second embodiment shown in Figure 6, the compensating element is provided in the form of a local projection 25 formed solely in the region of the end 22 of the guide rail 9 near the door, creating an offset as between the fastening hooks 23 and 24, thus providing the acute angle referred to in independent claim 1. This arrangement is explained on page 12 of the specification, where, in reference to Figure 6, it is explained that the local projection 25 is

formed solely in the region of the end 22 near the door, whose exterior surface, which faces the sidewall 8 and bears the vertical fastening hooks 24, is a greater distance from the legs 13, 15 of the guide rail 9 that guide the rollers 19 of the guided rail 10 than is the exterior surface in the environment of the horizontal hook 23. This configuration allows the guiderails 9 to extend at an acute angle relative to the sidewall 8, but parallel to each other, thus facilitating movement of the pull-out shelf via movement of the guided rails 10 within the guide rails 9.

It is respectfully submitted that there is no disclosure or even remote suggestion of any such compensating element in the DE '743 patent that would enable mounting of either one or both of the guide rails 32 at an acute angle relative to a respective side wall of the cold goods container so as to make the guide rails parallel to each other, and the Examiner has proffered no factual evidence to the contrary. In fact, the DE '743 patent neither recognizes nor solves the problem of how to make the guide rails parallel to each other when mounted on divergent side walls. Moreover, contrary to the Examiner's view, elements 34-37 of the D '743 patent are not capable of producing the effect specified in claim 1.

To the contrary, the "compensating elements" in the D '743 reference are configured to mount the guide rails parallel to the side walls of the cold goods container. Thus, the "structural difference" required by the Examiner is found in the lateral offset of the compensating element by reason of the wedge-shaped rail 20 or the side wall projection 25. There is no such offset in the D '743 patent, and thus no "compensating elements" as required in independent claim 1.

(ii) Claim 2

With regard to dependent claim 2, insofar as that claim further defines the compensating element as comprising a plurality of compensating elements, with each of the guide rails having one of the compensating elements and the compensating elements of the guide rails are mirror-symmetrical, the DE '743 patent fails to anticipate.

(iii) Claims 4 and 5

With regard to dependent claims 4 and 5, here again these claims further limit and define compensating elements that are nowhere disclosed in the '743 patent and therefore neither of claims 4 and 5 are anticipated by that reference.

(iv) Claim 13

With regard to dependent claim 13, the DE '743 patent does not disclose a compensating element (as defined in claim 1) that also has a contact surface carrying a hook. In the DE '743 patent, the hooks are carried on other guide rail surfaces that have no compensating capability.

(v) Claim 19

With regard to independent claim 19, that claim requires a compensating element mounting at least one guide rail of each of the pair of guide rails at one end of the side walls, at an acute angle to the side walls, the angle being defined to extend the rails and the pair of guide rails parallel to each other. Note also that the claim positively requires that the side walls of the container diverge.

Incorporating the arguments above relating to independent claim 1, there is nothing in DE '743 that discloses or suggests compensating elements that allow the guide rails 32 to be

mounted at an acute angle relative to diverging side walls of the container such that the guide rails themselves are parallel to one another. Accordingly, the subject matter of independent claim 19 is not anticipated by DE ‘743.

(b) Claims 10, 12, 14, 20 and 21

Dependent claims 10, 12, 14, 20 and 21 are not separately argued, and therefore stand or fall with the claims from which they depend.

Accordingly, for the reasons presented above, the Section 102 rejection of claims 1, 2, 4, 5, 10-14, 19, 20 and 21 is improper and should be reversed.

2. The Combination of DE ‘743 And Kaiser Does Not Establish *Prima Facie* Obviousness As To Dependent Claim 6.

(a) claim 6

The USPTO has the initial burden of factually supporting any conclusion of *prima facie* obviousness (35 USC 103) with respect to the claimed invention. See *In re Rineheart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). In its recent decision, the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (April 2007), held that it is often necessary for a court to look to interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace and the background knowledge possessed by a person of ordinary skill in the art in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. The Supreme Court held that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1396.

The Supreme Court in its *KSR* decision went on to say that it followed the Court of Appeals for the Federal Circuit’s advice that “rejections on obviousness grounds cannot be

sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (the Supreme Court quoting from the Court of Appeals for the Federal Circuit in *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006)).

Here, the Examiner cites the secondary reference to Kaiser for teaching the idea of providing a cooling apparatus with a pair of guide rails wherein each guide rail comprises a compensating element having a wedge shape that extends substantially over an entire length of the guide rail (see Fig. 6) for the purpose of compensating for at least of one oblique position of the pull-out shelf/storage compartment. See Final Rejection, p. 4. The Examiner concludes that it would have been obvious to modify the structure of the DE ‘743 reference by providing the compensating element with a wedge shape extending substantially over an entire length of the guide rail as taught by Kaiser.

Kaiser clearly does not suggest any modification of the apparatus in ‘743 that would result in the structure of claim 6.

As explained in the paragraph bridging columns 8 and 9 of Kaiser:

If the storage compartment is moved from its open position ((see Fig. 1) in which the section 71 engages with its external toothed configuration 71.1 in the mating toothed configuration 74) and then into the cooling chamber 14, the section 71 is pushed by the sloping plane 57 at the end of the insertion path out of engagement of the mating toothed configuration 54 by the sloping plane 57 that is disposed on the guide profile 50 that faces the section 71. As a result, an oblique position of the storage compartment 58 is corrected by the disengagement (the oblique position possibly arising because an improper procedure of inserting the storage compartment 58. Thus the magnetic seal 27 of the door 26 provided at the front end of the storage compartment 58 seemingly rests all sides against the opening edge of the cooling chamber 14.

In other words, the sloping plane 57 serves to realign the storage compartment 58 from a misaligned position. The vertically-sloped plane 57 in Kaiser would not remedy the problem created by horizontally-divergent sidewalls, i.e., even if sloping planes were added to the '743 container sidewall(s), the sloping planes are not configured to mount the guide rails 32 at an acute angle to the respective divergent container side walls so that the guide rails extend parallel to one another. Note in this regard that the sloped plane 57 has no bearing whatsoever on the orientation of the guide track or profile 50 (Figs. 5 and 6). Rather, the sloped plane 57 adjusts the position of the roller 65 via spring 68. Moreover, and in light of the Examiner's position that the claimed "compensating elements" in the '743 reference are the attachment tabs 34-37, it would not have been obvious to incorporate the sloping plane configuration of Kaiser into the attachment tabs of the '743 reference in any event since they are wholly-unrelated in both structure and function and any such modification would require wholesale reconstruction of the D'743 reference device that is nowhere contemplated or suggested by either reference.

Accordingly, the section 103 rejection of claim 6 is improper for failure to establish *prima facie* obviousness and should also be reversed.

CONCLUSION

In conclusion, the rejections of appealed claims 1, 2, 4-6 and 10-14 are improper and appellant respectfully requests that the decision of the Examiner finally rejecting the appealed claims be reversed.

The Commissioner is hereby authorized to charge any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 502786.

Respectfully submitted,

/James E. Howard/

James E. Howard

Registration No. 39,715

September 2, 2009

BSH Home Appliances Corporation
100 Bosch Blvd.
New Bern, NC 28562
Phone: 252-639-7644
Fax: 714-845-2807
james.howard@bshg.com

(VIII) CLAIMS APPENDIX

1. A guide assembly comprising:
a compensating element;
at least one pair of guide rails, each of the guide rails being mountable on a respective sidewall of a cold goods container of a cooling apparatus and the pair of guide rails being operable to guide a pullout shelf of a cold goods container such that the pullout shelf is configured to be guided by the pair of guide rails at least partway out of the cold goods container through an open front side of the cold goods container; and
said compensating element being configured to mount at least one guide rail of each of said pair of guide rails at one of the sidewalls at an acute angle to the sidewall, said angle being defined to extend said rails of said pair of guide rails parallel to one another.
2. The guide assembly according to claim 1, wherein:
said compensating element is a plurality of compensating elements;
each of said guide rails has one of said compensating elements; and
said compensating elements of said guide rails of said pair of guide rails are mirror-symmetrical.
4. The guide assembly according to claim 1, wherein said compensating element is formed at said guide rail in one piece.
5. The guide assembly according to claim 1, wherein said compensating element is integral with said guide rail.
6. The guide assembly according to claim 1, wherein said compensating element is wedge shaped and extends substantially over an entire length of said guide rail.
10. The guide assembly according to claim 1, wherein:

- said guide rail has a C-shaped cross-section with a top leg, a bottom leg, and a center piece joining said top and bottom legs; and
said compensating element is formed in said center piece.
11. The guide assembly according to claim 4, wherein:
said guide rail has a C-shaped cross-section with a top leg, a bottom leg, and a center piece joining said top and bottom legs; and
said compensating element is formed in said center piece.
12. The guide assembly according to claim 5, wherein:
said guide rail has a C-shaped cross-section with a top leg, a bottom leg, and a center piece joining said top and bottom legs; and
said compensating element is formed in said center piece.
13. The guide assembly according the claim 1, whererin:
said compensating element has a contact surface; and said guide rails carries, on said contact surface and said compensating element, at least one hook.
14. The guide assembly according to claim 1, wherein said guide rail has at least one hook.
19. A cooling apparatus, comprising:
at least one cold goods container having:
an open front side;
at least one pullout shelf;
sidewalls diverging in a direction of said front side; and
a guide assembly having:
a compensating element;
at least one pair of guide rails guiding said pullout shelf at least partway out of said cold goods container through said front side; and

- said compensating element mounting at least one guide rail of each of said pair of guide rails at one of said sidewalls at an acute angle to said sidewall, said angle being defined to extend said rails of said pair of guide rails parallel to one another.
20. The guide assembly according to claim 1 and further comprising a C-shaped cross-section with a top leg, a bottom leg, and a center piece joining said top and bottom legs, said compensating element being formed at said center piece.
21. The guide assembly according to claim 2 and further comprising at least one hook protruding through an opening of a sidewall of a cold goods container for a cooling apparatus.

Karl Friedrich Laible
Serial No. 10/725,088

(IX) 1. EVIDENCE APPENDIX

None.

Karl Friedrich Laible
Serial No. 10/725,088

(X) RELATED PROCEEDINGS APPENDIX

None.